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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,969	07/03/2001	Ramesh Lhila	6001-44-1	9960

7590 06/25/2003
McCormick, Paulding & Huber
City Place II
185 Asylum Street
Hartford, CT 06103-3402

EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

14

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-14

Office Action Summary	Application No. 09/898,969	Applicant(s) LHILA, RAMESH	
	Examiner Hai Vo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8, 11-14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everaerts et al (US 5,612,136) substantially as set forth in the Paper no. 11.
3. Claims 9, 10, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everaerts et al (US 5,612,136) as applied to claim 1 in view of Ko et al (US 5,308,887) substantially as set forth in Paper no. 11.
4. Claims 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everaerts et al (US 5,612,136) as applied to claim 1, in view of Mazurek et al (US 5,264,278) substantially as set forth in Paper no. 11.
5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Everaerts et al (US 5,612,136) as applied to claim 1, in view of Ko et al (US 5,308,887) and Mazurek et al (US 5,264,278) substantially as set forth in Paper no. 11.
6. Claims 41 and 42 have been cancelled in the amendment received on 04/21/2003.

Double Patenting

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7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 09/920,182 in view of Everaerts et al (US 5,695,837). Claims 1-22 of copending Application No. 09/920,182 read on every element of the presently claimed subject matter except the presence of a primer between the acrylic foam-like backing layer and the pressure sensitive adhesive layer. Everaerts does disclose the presence of the primer layer between the acrylic foam core and the pressure sensitive adhesive (column 10, lines 30-31 and table 9). The foam tapes with the use of a primer are subjected to 180° Peel Adhesion testing. The results of the tests in Table 9 show interfacial failure between the primer and foam backing (FP). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a primer layer between the acrylic foam-like backing layer and the adhesive layer of the copending Application No. 09/920,182 motivated by the desire to provide an

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improved adhesion between the acrylic foam-like backing layer and the adhesive layer.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

9. The 103 art rejections over Ko have been overcome by the present amendment and response.

10. The art rejections over Everaerts have been maintained because of the following reasons. Applicants argue that there is no teaching or suggestion in Everaerts that an acrylic pressure sensitive tape comprising a primer layer disposed between the layer of acrylic backing and the pressure sensitive adhesive. This is not found persuasive. Everaerts does disclose the presence of the primer layer between the acrylic foam core and the pressure sensitive adhesive (column 10, lines 30-31 and table 9). The foam tapes with the use of a primer are subjected to 180° Peel Adhesion testing. The results of the tests in Table 9 show interfacial failure between the primer and foam backing (FP).

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The

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fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
June 23, 2003



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700